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5/18/06

**PATENT EXAMINER
IFW REISSUE APPLICATION CHECKLIST**

Examiner:

Anatoly Vortman

Art Unit:

2835

Reissue Appl. No.:

10/766, 751

THIS CHECKLIST IS PROVIDED AS AN AID TO THE REISSUE EXAMINATION PROCESS. IT SHOULD BE USED THROUGHOUT PROSECUTION AND MUST BE REMOVED FROM THE FILE AT THE TIME OF ALLOWANCE AFTER APPROVAL BY THE SPRE.

Reissue applications are considered “SPECIAL” (MPEP § 1442). Any reissue application appearing on an examiner’s docket report should be taken up for action as the next new or amended case, even before other special applications.

Prior to examining a reissue application, the examiner should obtain and review the original patent file if the patent issued from a paper application, or should access the original patent’s file history if the patent issued from a paper application. MPEP § 1440. Examination of the reissue application is frequently directly linked to the prosecution history of the original application for the patent to be reissued.

ALL CLAIMS IN THE REISSUE APPLICATION ARE SUBJECT TO A FULL EXAMINATION ON THE MERITS, INCLUDING THE RE-PRESENTED ORIGINAL CLAIMS OF THE PATENT.

I. Examiner: Complete items 1-19 prior to completing a first Office action. In some TCs, before mailing the action, send an IFW message to the SPRE and hand carry this form to the SPRE.

II. SPRE has reviewed before first action. [For TCs where this is carried out.] This form is then returned by the SPRE to the examiner for storage.

_____ (SPRE initials)

Examiner - Complete items 20-21 when preparing the reissue application for allowance.
SPRE - Place initials of approval on the Reissue IFW Final SPRE Review Form that is scanned into the file history at the time of review for allowance.

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REISSUE CHECKLIST FOR IFW REISSUES

5/18/06

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IFW Reissue Application Checklist

A “Reissue Guide” containing a further explanation of most of the items on the checklist is available in paper form or electronically (by e-mail) from the Technology Center SPRE or Paralegal.

Indicate that each of the applicable items set forth below has been thoroughly reviewed with respect to the above-identified reissue application by answering YES, NO, or N/A to the following questions. If additional discussion is needed, check one of the first three boxes, and ALSO check the fourth box and provide the additional discussion where indicated below. See TC SPRE for further assistance, if needed.

1. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Has the original patent file wrapper in paper, or file history in IFW, been obtained and reviewed?
If NO, see “Reissue Guide” for further assistance.

2. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Is the original patent still in force, i.e., it has not expired due to the conclusion of its patent term or due to the non-payment of the scheduled maintenance fees? *A reissue application must actually issue as a reissue patent before expiration of the original patent. Accordingly, always make sure the patent has not expired; this should be monitored throughout the prosecution of the reissue application. See “Reissue Guide” for methods of checking patent term.*

3. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Has notice of the filing of the reissue application been published in the *Official Gazette (O.G.)*? *If NO, STOP action and have your TC Paralegal forward the application to OIPE to effect publication. Reissue RCEs are not announced in the O.G.*

4. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Is the current date more than two months after the O.G. publication date? *If NO, wait until the two-month period has expired before preparing and issuing an Office action, unless directed otherwise by an Office of Patent Legal Administration or Office of Petitions decision in the file. Continuation/divisional reissues may be acted upon before the expiration of the two-month period.*

5. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Has the file been reviewed for the presence of any protests under 37 CFR 1.291(a)? *Protests may be filed during the two-month period following the O.G. notice, or anytime up until the Notice of Allowance, and should be considered in the next Office action, if in the file. See “Reissue Guide” for instructions on handling protests.*

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6. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Is the reissue application a division or a continuation of another pending reissue application, or is there a child reissue application that is a division or continuation of this reissue application?

Divisional and continuation reissue applications are permissible as held in In re Graff, 42 USPQ2d 1471. If YES, special handling as per the "Reissue Guide" is required. See Item 18 below for restriction practice.

7. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Is the patent or the reissue application involved in litigation? *Information is requested from the STIC if not found in the file. If YES, a shortened reply periods may have to be set by the Examiner, or prosecution may have to be suspended. See "Reissue Guide." If NO, proceed with examination.*

8. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

If the reissue application has been assigned, does it include the written consent to the filing by all of the assignees (37 CFR 1.172(a))? *See MPEP § 1410.01. If NO, and a petition for a waiver of this requirement has been granted, the assent may be deferred until the application is otherwise allowable.*

9. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Have all documents (in applications filed on or after September 24, 1992) which are signed by, or on behalf of, the assignee(s) been reviewed and found to comply with the provisions of 37 CFR 3.73(b)? *This includes "consent" in No. 8, above. If NO, the statement under 37 CFR 3.73(b) must be required before allowance.*

10. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Were any changes made to the patent by a Certificate of Correction dated prior to the filing of the reissue? *If YES, check to see if the changes were properly entered as though part of the original patent, i.e., entered with no brackets or underlining.*

11. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Has the application been reviewed for the presence of any errors, including any not specifically identified, which are not correctable by reissue? *Reissue doesn't cure all patent ills. See "Reissue Guide" for listing of some errors which cannot be corrected by reissue.*

Reissue Application Checklist

12. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Are any claims broader in scope (in ANY respect) than the original patent claims? *If YES, note 35 USC 251, 3rd and 4th paragraphs as to potential rejections. If NO, proceed to item 14.*

13. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Does the broadening (from Item 12) attempt to "recapture" any claimed subject matter with respect to that which was added, or argued, to overcome a rejection in the original application? *See "Reissue Guide" for explanation of "recapture doctrine." Subject matter deliberately surrendered may not be recaptured (reclaimed) in a reissue application.*

14. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Does the reissue application seek to provoke an interference with another patent? *If NO, proceed to Item 16. If YES, see "Reissue Guide."*

15. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Do the issues of interference estoppel and the "lost count" doctrine apply? *These issues apply to the losing party of an interference. See "Reissue Guide."*

16. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Does the application include drawings (copies or originals) which meet the requirements of 37 CFR 1.84? *If YES, be sure there are no amendments or additions to the original figures. Transfer of the drawings from the patent file is not done by the Office.*

17. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Does the reissue oath or declaration comply with all of the requirements of 37 CFR 1.63 and 37 CFR 1.175? *See list of requirements in "Reissue Guide." If NO, reject under 35 U.S.C. 251 (citing the relevant portion of 37 CFR 1.63 or 1.175).*

18. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Does the reissue application contain claims to more than one invention (37 CFR 1.176)? *If YES, and the different inventions were claimed in the patent, a restriction requirement dividing the different inventions cannot be made in the reissue application. If added claims in the reissue application are drawn to an invention not previously claimed, a restriction is possible. See Reissue Guide.*

Reissue Application Checklist for Paper Reissues

19. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

Is the original patent currently involved in a reexamination proceeding? *To determine this, check "Continuity" in PALM for the original patent number. If YES, forward/message all related files (including any reexam or reissue directed to the original patent) to the TC SPRE who will e-mail the Office of Patent Legal Administration (OPLA) for consideration of a merger of the reexam and reissue proceedings.*

THE FOLLOWING QUESTIONS SHOULD BE COMPLETED WHEN PREPARING THE APPLICATION FOR ALLOWANCE:

20. ☒ Yes ☐ No ☐ N/A ☒ See additional discussion below

Have all amendments to the specification, drawings and claims been reviewed and found to comply with 37 CFR 1.173(b)? *See amendment practice described in "Reissue Guide." If NO, amendment in accordance with 37 CFR 1.173(b) will be required.*

21. **The following items should be verified at the time of Allowance:**

- a. ☒ Yes ☐ No ☐ N/A ☐ See additional discussion below

None of the original patent claims have been renumbered.

- b. ☒ Yes ☐ No ☐ N/A ☐ See additional discussion below

The final numbering of claims added by reissue must follow the number of the highest numbered original patent claim.

- c. ☒ Yes ☐ No ☐ N/A ☐ See additional discussion below

The claim selected for printing is one that was added or amended during reissue - never a canceled claim. (Where no claim is amended/added, print the same claim as was printed in the original patent).

- d. ☒ Yes ☐ No ☐ N/A ☐ See additional discussion below

On the Issue Classification sheet, the final claim numbering **must** be filled in properly. A canceled patent claim retains its original number although it is not considered in the total number of claims allowed. Therefore, on the Issue Classification Sheet, the number in the box designated "TOTAL CLAIMS ALLOWED" may be less than the highest number of the last allowed claim.

IFW Reissue Application Checklist for Reissues

- e. ☐ Yes ☐ No ☒ N/A ☐ See additional discussion below

Any Examiner's Amendment that makes a change to the patent which change is substantive in nature may necessitate a supplemental reissue oath/declaration from applicant.

- f. ☒ Yes ☐ No ☐ N/A ☒ See additional discussion below

Classification and cross referencing on the Issue Classification Sheet should include at least those classes and subclasses designated on the original patent. If a reclassification prevents use of the same class/subclasses, the new class/subclasses should be used.

- g. ☐ Yes ☐ No ☐ N/A ☐ See additional discussion below

The SPRE should be informed of the relevant Terminal Disclaimer (TD) information for TDs filed either in the original patent or in the reissue application. (An informal note will be sufficient). That information will be placed in the IFW file wrapper via the SPRE's completion of the SPRE review sheet as set forth below.

- h. ☒ Yes ☐ No ☐ N/A ☐ See additional discussion below

For any reissue error corrected which is not covered by an oath or declaration, i.e., any 35 U.S.C. 251 error corrected after the filing of all oaths and declarations currently in the reissue application, applicant **MUST** submit a "catch-up" supplemental oath or declaration prior to allowance stating " *Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.*" (37 CFR 1.175(b)(1)), or language equivalent thereto. See MPEP § 1444 for handling supplemental oaths/declarations.

- i. ☐ Yes ☒ No ☐ N/A ☐ See additional discussion below

Any "correction/or addition" of a domestic or foreign priority/benefit claim is permitted, and was made, pursuant to MPEP 1402.

The red Action folder including the Issue Classification Sheet for each allowed reissue application, together with the original patented file, if in paper, is submitted to the TC SPRE for review prior to being released from the Technology Center. Any IFW files should be messaged to the SPRE. The SPRE will complete the SPRE review sheet (Document Code REIS.REVFORM) at this point (including any relevant terminal disclaimer information supplied by the examiner), and place it into the red action folder to have it scanned into the file history. Once the reissue has been approved and revised for issue, any paper files

Reissue Application Checklist for Paper Reissues

(e.g., the original patent, if it is in paper format) should be sent to the Office of Patent Legal Administration (OPLA), and any IFW files should be messaged to the OPLA.

This checklist is to be removed from the Action Folder by the SPRE at the time of final review.

All reissue applications are screened by the Office of Patent Legal Administration (OPLA). Thus, the office of the SPREs will "message" the OPLA IFW reissue mailbox, after the TC has finished working on the case, e.g., counted, mailed, and image uploaded to IFW of all work.

Examiner:

A.V.

Date:

08/19/09

☒ Additional comments/discussion as to the above items:

- a.) In re #20, All original patent claims 1-4 have been canceled by a statement according to 37 CFR 1.173(b)(2), without presentation of the text of the claims in square brackets.
- b.) In re # 21(4), original classes/subclasses in class 361 have been abolished due to reclassification. Therefore, new class/subclasses have been used.

A.V.